

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARK: SOLUTION

SERIAL NO.: 87/417,396 LAW OFFICE: 117

FILING DATE: April 19, 2017 EXAMINING ATTORNEY: RYDLAND, Stephanie

APPLICANT(s) HIGHRES BIOSOLUTIONS, INC.

ATTORNEY

DOCKET NO.: 1234-003224-US (-TM)

Commissioner for  
Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE**

**I. INTRODUCTION**

This is in response to the Office Action mailed July 21, 2017 (hereinafter, the "office action") in regard to the above-identified trademark application. Reconsideration of the refusal is respectfully solicited in light of the following remarks.

## II. AMENDMENTS

Software for laboratory and scientific equipment namely, for  
operating liquid handling robotic workstations, robotic  
pipetting workstations, and robotic systems comprising fixed  
and/or mobile robots, operating software, cameras, communication  
systems, sensors and computers for personal human use

## II. REMARKS

1. The Examining Attorney has indicated that no similar registered marks have been found that would bar registration under Trademark Act Section 2. However, the Examiner has noted that a prior filed application (U.S. Application No. 87093897) precedes applicant's filing date and may result in refused registration of the Applicant's mark SOLUTION on the grounds of a likelihood of confusion with the mark PURIFICATION SOLUTION in 87093897. A thorough analysis and of the significant differences in the marks and the goods/services leads to the conclusion that the Examiner will not be able to carry the burden of establishing a likelihood of confusion.

The Applicant's goods are "software for laboratory and scientific equipment namely, for operating liquid handling robotic workstations, robotic pipetting workstations, and robotic systems comprising fixed and/or mobile robots, operating software, cameras, communication systems, sensors and computers for personal human use."

The Examiner is reminded that a mark may be barred from registration only if it so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services. See 15 U.S.C. 1052(d). In other words, whether there is a likelihood of confusion to consumers (not merely in the abstract) as to the source or sponsorship of the goods or services because of the marks used thereon. See, e.g., Paula Payne Prods. Co. v Johnson's Pub'g Co., 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A 1973) (TMEP 1207.01). The relevant factors to determine likelihood of confusion are discussed in the In re E.I. du Pont case which also stated that not all factors are relevant and a case by case determination

is warranted. See In re E.I. du Pont de Nemours & Co. 476 F.2d 1357, 177 USPQ 563 (C.C.P.A 1973). In no case however, is it proper to limit the factors merely to finding a bare relationship between the recited goods where differences in the Applicant's related goods limit content and method of distribution. Ford Motor Co. v. Ford, 462 F.2d 1405 (Cust. & Pat. App. 1972).

The Applicant respectfully submits that the cited prior filed application (87093897) is not likely to cause consumer confusion, mistake, or deception as to the source of the goods/services. Despite the fact that the word marks each contain the term SOLUTION, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods and services and all of the du Pont factors must be considered (TMEP 1207.01(b)). The Applicant submits that the following factors are most relevant: similarity or dissimilarity of the marks and similarity or dissimilarity and nature of the goods/services as described in the application.

**1A. SIMILARITY OR DISSIMILARITY OF THE MARKS:**

It is noted that the addition of terms to marks may be sufficient to avoid a likelihood of confusion if (1) the marks in their entirety convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted" (TMEP 1207.01(b)(iii)). When comparing Applicant's mark SOLUTION and the prior filed application's mark PURIFICATION SOLUTION, as a whole, the prior filed application's mark is different in appearance, sound, and overall commercial impression so as to avoid a likelihood of

confusion. For example, the mark of the prior filed application (87093897) contains the addition of PURIFICATION which is sufficient to avoid likelihood of confusion, because PUURIFICATION forms the dominant portion of the mark (as further discussed below).

Additionally, the Examiner is reminded that "evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 1373 (Fed. Cir. 2005). As evidenced by, for example, a search result, attached herewith as Appendix A, it is clear that at least the term SOLUTION in the applied for mark PURIFICATION SOLUTION is weak, with respect to compound marks, in the related fields. Several of the compound marks with the term SOULTION, listed in the search result, each with goods/services that are commercially related (i.e., in the field of science and laboratory equipment), have coexisted in use in commerce for at least a few years without any confusion. The existence of another mark, by a third party, using identical terms (i.e., SOLUTION) related to the relevant fields serves to indicate that the term SOLUTION in the applied for mark PURIFICATION SOLUTION is only entitled to a narrow scope of protection.

Thus, the addition of the dominant term PURIFICATION coupled with the weakness of SOLUTION for compound marks in the related field demonstrates that no consumer would be confused, mistaken, or deceived with respect Applicant's mark and the applied for mark in application 87093897.

**1B. SIMILARITY OR DISSIMILARITY AND NATURE OF THE GOODS/SERVICES:**

Additionally, the goods/services are not so related that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.

The goods/services of the prior filed application 87093897 are "laboratory apparatus and instruments, namely, liquid chromatographs, mass spectrometers and liquid chromatography-mass spectrometers; Downloadable software used in the process of powderizing of the target compounds of the fraction for use in liquid chromatographs, mass spectrometers and liquid chromatography-mass spectrometers; Computer software recorded used in the process of powderizing of the target compounds of the fraction for use in liquid chromatographs, mass spectrometers and liquid chromatography-mass spectrometers" in IC 009. These goods/services are not so related to Applicant's goods/services that they would cause consumer confusion, mistake, or deception. Thus, consumer confusion, mistake, or deception is not likely. Again, the Applicant's goods/services are "software for laboratory and scientific equipment namely, for operating liquid handling robotic workstations, robotic pipetting workstations, and robotic systems comprising fixed and/or mobile robots, operating software, cameras, communication systems, sensors and computers for personal human use."

The goods of the prior filed application are specifically for "Computer software recorded used in the process of powderizing ..." As the application specifically limits the goods to this type of software, the goods cannot be broadened to cover software for operating, e.g., liquid handling robotic workstations and robotic pipetting workstations.

Additionally, Applicant's goods/services are software for operating automation systems such as liquid handling robotic workstations. The goods/services of application 87093897 is software related to used in the process of powderizing of the target compounds of the fraction for use in liquid chromatographs, mass spectrometers and liquid chromatography-mass spectrometers. Both Applicant's and the prior filed application's good are used in connection with expensive/sophisticated machinery. Both applications goods (Applicant's and the prior filed application) are directed toward sophisticated consumers in their related field.

Applicant respectfully submits that it's reasonable to set a higher standard of care than exists for ordinary consumers, where a relevant buyer class is composed of professionals familiar with the field. These professional buyers are usually knowledgeable enough and less likely to be confused by trademarks that are similar. See Haydon Switch Instrument, Inc. v. Rexnord, Inc., 4 U.S.P.Q.2d 1510, 1987 WL 26062 (D. Conn. 1987) (Sophisticated purchasers enter the marketplace in search of specific products for specific industrial purposes. Sophistication of these purchasers makes the likelihood of confusion remote). Scientific institutions and scientists purchasing the prior filed applications goods are not average every day consumers and would exercise a high degree of knowledge and care with respect to purchases made for the liquid chromatographs, mass spectrometers and liquid chromatography-mass spectrometers and the software used therewith.

Further, when factoring that the cost and sophistication of liquid chromatographs, mass spectrometers and liquid chromatography-mass spectrometers, which can be as much as hundreds of thousands of

dollars and are intricate machines which require significant familiarity to operate, a consumer can be expected to pay particular attention regarding purchases for these machines and their related software and would likely make a careful personal examination before purchasing. These goods are not the type that a reasonably prudent purchaser would buy without researching the product to some degree but rather will be purchased with care and deliberation (see Tiffany & Co. v Classic motor Carriages Inc., 10 USPQ2d 1835, 1841 (TTAB 1989)). Thus, no consumer would be confused, mistaken, or deceived as the consumer can be expected to exercise a high degree of knowledge and care when purchasing either Applicant's or Registrant's goods/services.

Therefore the goods/services are not so related to Applicant's goods/services that they would cause consumer confusion, mistake, or deception. Thus, consumer confusion, mistake, or deception is not likely.



